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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,277	11/28/2000	Oivin M. Guicherit	CIBT-P04-072	7556

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EXAMINER

RAO, DEEPAK R

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/724,277	<b>Applicant(s)</b> GUICHERIT ET AL.	
	<b>Examiner</b> Deepak R Rao	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 are pending in the application.
- 4a) Of the above claim(s) 41-43 are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-40 are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

This office action is in response to the amendment filed on December 9, 2003.

Claims 1-43 are pending in this application.

***The following rejections are maintained:***

Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of formula I, II and III, does not reasonably provide enablement for all other compounds embraced by the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant argues that the specification provides at least three distinct classes of compounds 32-35 (which represent formula II), 47-49 (representing formula I) and 77-82 (which represent formula III) and further submits that additional compounds may be identified through the use of chemical libraries. However, screening through chemical libraries is a very extensive involving millions of drug samples. The Drug & Market Development article provides that "However, once candidate compound(s) have been identified from a primary screen, the subsequent characterization of these lead compounds is an information-intensive exercise. Often, a large number of discrete pieces of data need to be accumulated to arrive at the conclusion of whether or not a given hit is worth pursuing further in animal and preclinical studies" (see page 91, col. 1). This is indicative of the amount of experimentation required for

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the skilled artisan which is beyond routine lab work. Oftentimes, it has been urged that UHTS is rather wasteful and inefficient.

For all the above reasons, the rejection is maintained.

*The following rejections are under new grounds:*

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-40 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/41545 (published July 20, 2000). The reference teaches a method for inhibiting aberrant growth states resulting from hedgehog pathway in an amount sufficient to antagonize hedgehog activity. The instant claims read on reference disclosed method.

2. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Baxter et al., U.S. Patent No. 6,545,005 (filed September 15, 2000). The reference teaches a method for inhibiting aberrant growth states resulting from hedgehog pathway in an amount sufficient to antagonize hedgehog activity. The instant claims read on reference disclosed method.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

**Note:** It is acknowledged that the instant application is a CIP of S. No. 09/663,835 which claims benefit of Provisional Applications. However, S. No. 09/663,845 or the provisional application(s) upon which priority is claimed, fail to provide adequate support under 35 U.S.C. 112 for claims of this application. Specifically, the prior applications do not provide support for the entire genus of instant claims, e.g., compounds 77-82 which fall within the scope of the instant claims were not disclosed in the prior applications. Accordingly, the effective filing date for the instant claims is November 28, 2000.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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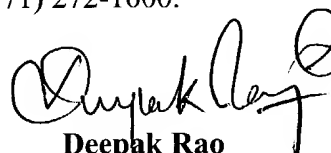
Claims 1-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,545,005. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims substantially overlap the reference claims. The reference also teaches a method of inhibiting hedgehog pathway with a hedgehog antagonist of formula II. It would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the hedgehog antagonists including those taught by the reference, because the skilled chemist would have had the reasonable expectation of obtaining similar results.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

April 19, 2004